

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUNTER HALMSCHLAGER,
FRANZ STELZHAMMER, ERICH BRUNNAUER,
MANFRED GLOSER, MANFRED FEICHTINGER
THOMAS NAGLER, JOHANNES STIMPFL,
JOSEF BACHLER, and CHRISTOPH MERCKENS

MAILED

MAY 25 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-0731
Application No. 09/646,119

HEARD: APRIL 27, 2006

Before KIMLIN, KRATZ, and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REMAND

This is an appeal from the final rejection of claims 46-52 and 62-64. The examiner has withdrawn the rejection of claims 75-97. Claim 46 is illustrative:

46. A machine for the production of a multi-layered fibrous web, comprising:
 - at least two formers for forming at least two layers in which each layer has a higher content of fines on one side respectively; and
 - a couching zone in which the at least two layers are couched together such that each layer's side having a higher content of fines contact each other;
 - wherein at least one of the at least two formers comprises at least one gap former.

Claims 46, 47, and 74 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Turner. Claims 48-52 and 62-73 stand rejected 35 U.S.C. § 103(a) as being unpatentable over Turner in view of Loynd, Farrington, Manning, and GB ' 766.

The threshold issue on appeal is whether the apparatus of Turner is capable of operating in a manner wherein at least two layers are couched together in a couching zone “such that each layer’s side having a higher content of fines contact each other” (claim 46). The examiner appreciates that Turner does not disclose that two layers are formed “in which each layer has a higher content of fines on one side respectively” (claim 46). It is the examiner’s position, however, that Turner describes a machine having the claimed structure of at least two formers and a couching zone, with at least one of the two formers being a gap former, and that the apparatus of Turner “is inherently capable of being used as claimed . . .” (page 8 of Answer, first paragraph). The examiner indicates that there is not sufficient structure defined in the appealed claims to distinguish over the structure of Turner. The examiner has not, however, explained how the apparatus of Turner is capable of operating as presently claimed. The examiner has supplied no analysis which explains why the apparatus of Turner can be used to form two layers with the claimed distribution of fines.

Appellants, on the other hand, fail to point to any particular structural feature of the claimed machine that is not present in the machine of Turner. The thrust of appellants’ argument is that Turner does not teach that the disclosed apparatus has at least two formers which form at least two layers having a higher content of fines on one side than the other, and a couching zone which brings together the sides of the layers that have the higher content of fines. The argument is made that “because TURNER provides no

disclosure that each web layer is formed to have one side with a higher fines content than that other, Appellants submit that the Examiner's assertions that TURNER is structurally the same as the recited invention is without basis in the art of record" (page 7 of principal Brief, second paragraph). Significantly, however, appellants have presented no argument which points to an actual structural distinction between machines within the scope of the appealed claims and machines fairly taught by Turner. Nor do appellants make the requisite assertion that the apparatus of Turner is incapable of forming at least two layers within the scope of the appealed claims.

Consequently, based on the deficiencies of the positions espoused by the examiner and appellants outlined above, we find that the present appeal is not ripe for decision. Accordingly, this application is remanded to the examiner for the purpose of allowing the examiner to explain why the apparatus of Turner is capable of forming at least two layers in accordance with the claimed invention, and to give appellants the opportunity to specify any specific structural features of the claimed machine that are not described by Turner.

The examiner should also consider the obviousness of the claimed invention, including claims 46, 47, and 74, within the meaning of 35 U.S.C. § 103 based on the Turner disclosure that it was known in the art that bonding adhesion between layers is improved as the concentrations of fines at the mating surfaces are increased (see the background section of Turner, particularly column 1, lines 36 et seq.). Since it was known to increase fines at the mating surfaces in order to improve bonding, the question arises regarding the significance of appellants' layers having less fines at the non-bonding surfaces.

Also, the examiner and appellants should avail themselves of this opportunity to clarify for the record the structural differences between machines within the scope of the appealed claims and the apparatus of the admitted prior art discussed at page 1 of the present specification. It must be emphasized that any distinction between the claimed machine and the apparatus of the admitted prior art must be with respect to the structures of the relevant machines, and not to how these machines are used.

This remand to the examiner pursuant 37 CFR § 41.50(a)(1) (effective September 13, 2004) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's Answer is written in response to this remand by the Board.

REMANDED

Edward C. Kimlin
Edward C. Kimlin)
Administrative Patent Judge)

Peter F. Kratz
Peter F. Kratz) BOARD OF PATENT
Administrative Patent Judge)

Catherine Timm
Catherine Timm) APPEALS AND
Administrative Patent Judge)
INTERFERENCES)
)

ECK/cam

Appeal No. 2006-0731
Application No. 09/646,119

Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191